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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/801,725	03/09/2001	Tim King	1591.0050001/RES/RDL	5084

919 7590 07/25/2005

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EXAMINER

DANG, KHANH

ART UNIT	PAPER NUMBER
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2111

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/801,725  
Filing Date: March 09, 2001  
Appellant(s): KING ET AL.

George M. Macdonald  
For Appellant

**EXAMINER'S ANSWER**

pd

This is in response to the appeal brief filed 7/7/2005.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Grounds of Rejection To Be Reviewed on Appeal***

The appellant's statement of the grounds of rejection to be reviewed on appeal in the brief is correct.

**(7) *Claims Appealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) *Prior Art of Record***

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5,699,528	Hogan	12/1997
6,343,327	Daniels, Jr. et al.	1/1002
5,944,787	Zoken	8/1999
6,015,167	Savino et al.	1/2000
6,775,690	Creswell et al.	8/2004
6,732,278	Baird, III et al.	5/2004

Infospace, Finding email address using Physical Address

Microsoft Outlook

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 112***

Claims 8 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 8, line 4, the phrase, "sending an email using physical address of a recipient" is unclear. As disclosed, an email is sent to a recipient using e-mail address after matching the recipient's physical address with the recipient's e-mail address.

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In claim 10, lines 12-13, the phrase, "the physical address of said buyer is used to send said email" is unclear. As disclosed, an email is sent to a recipient using e-mail address after matching the recipient's physical address with the recipient's e-mail address.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 11, 13, 14, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan.

With regard to claims 1, 5, and 14, Hogan discloses a system for routing e-mails, comprising: a server (160, column 4, lines 36-44; column 9, lines 50-60; column 5, lines 22-36, for example) that includes a database, the database including a physical addresses and e-mail addresses of subscribers or recipients; in Hogan, each regular mail of a subscriber or recipient has a corresponding email address, wherein the server (160) is connected to a network (internet network 110, for example), the server (160) further including an electronic mailbox (email box) for each physical address (regular

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mail, each subscriber or recipient must enter a physical address and email address into the data base of the server 160, see at least column 5, lines 25-35), wherein the electronic mailbox is associated with an account number and password (see at least Fig. 2a and description thereof; column 5, line 62 to column 6, line 8; column 10, lines 40-46); and a recipient host (PC 100 employed by a subscriber or recipient, for example) that includes a web browser, the recipient host connected to the network (110), wherein the host can access e-mails on the server (160) using the account number and the password. With regard to claim 2, it is clear that in Hogan, the recipient can print the email from the server (160), or the email can be printed and sent to the subscriber or recipient via regular mail if the subscriber or recipient chooses not to electronically make a payment by exiting the payment page. The recipient can also choose not to open the email, and as a result, the e-mail be printed and forwarded to the recipient via regular mail. With regard to claim 3, as discussed in claim 2, it is clear that the server (160) provides a graphical user interface (see Figs. 3 and 4, for example) that allows a recipient to select whether electronic mail is delivered to the electronic mailbox by selecting "203, receive and pay bill"; or is delivered via traditional mail by choosing not to electronically make a payment by exiting the payment page, or the recipient can also choose not to open the email, and as a result, the e-mail be printed and forwarded to the recipient via regular mail. With regard to claim 4, at the outset, in claim 4, line 4, before "to forward," the word "recipient" is a typo error and should be changed to --server --. It is clear that the server 160 includes a host mail with web browser, and the host mail includes a graphical user interface to forward email 107, Fig.

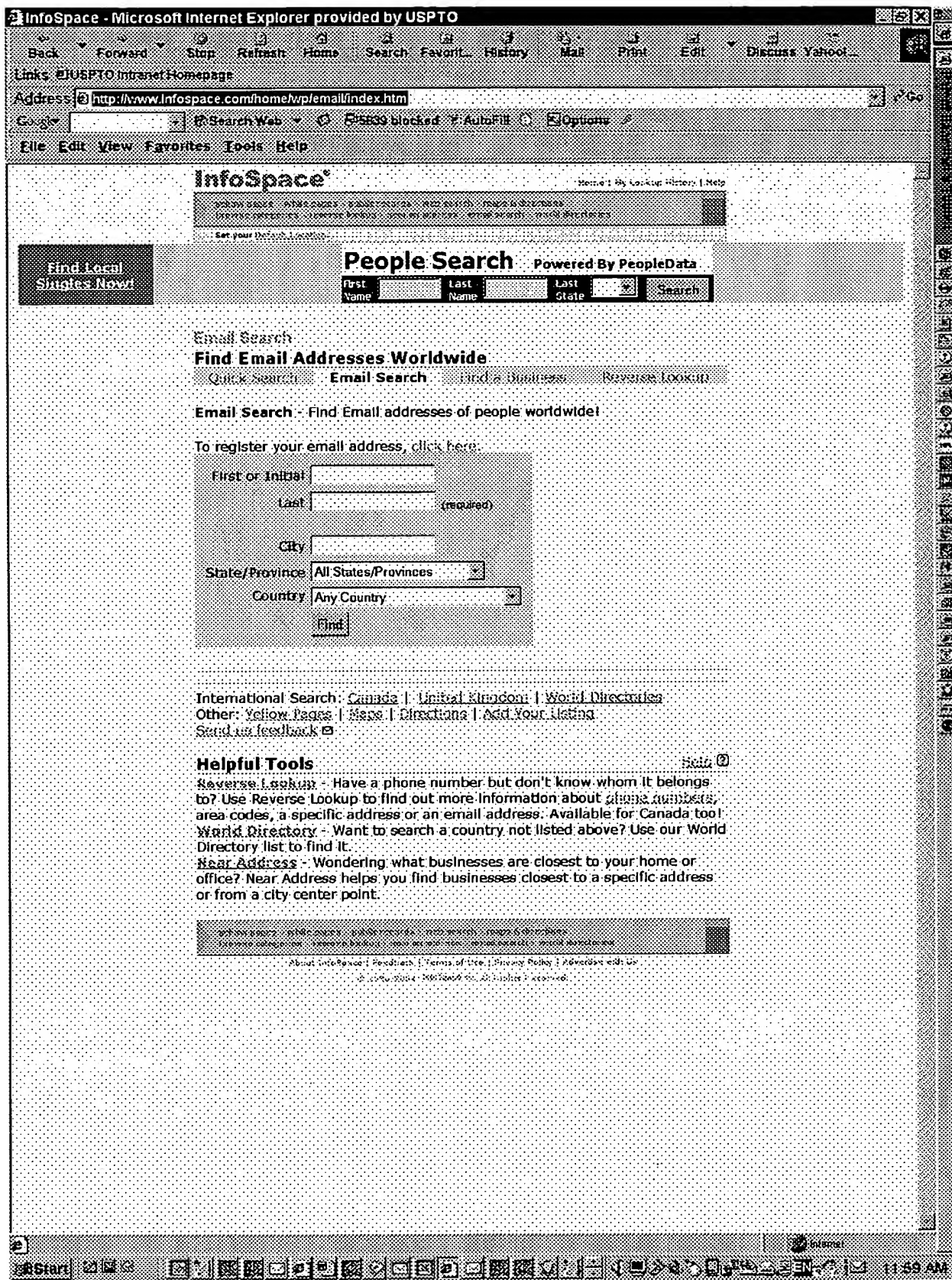
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11, for example) to a recipient. With regard to claim 11, it is clear that the address of a user stored in a database can always be edited. With regard to claim 13, as discussed above, it is clear that each recipient is assigned with an email box. With regard to claim 16, it is clear that emails can be printed and mailed via traditional mail. Furthermore, Hogan discloses that physical address and email address of a recipient are stored in a database.

Hogan does not disclose a means for mapping a physical address of a recipient to an email address of the recipient.

However, mapping a physical address to an email address is old and well-known in the art as evidenced by Infospace, cited in the previous Office Action. Infospace provides an option of mapping a physical address to an email address; or in other words, searching a person's email address using a person's physical address in a database comprising the person's physical address and email address. The following is a screenshot showing a typical search engine mapping an email address to a physical address:

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hogan with an option of mapping a physical address to an email address; or in other words, searching a recipient's email address using a recipient's physical address in a data base comprising a recipient's physical address and email address, since the Examiner takes Official Notice that mapping a physical address to an email address; or in other words, searching a recipient's email address using a person's physical address in a data base is old and well-known as evidenced by at least Infospace, cited in the previous Office Action; and providing such a search capability to the e-commerce server 106 of Hogan, since a search engine is important and vital to the success of e-commerce, only involves ordinary skill in the art.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan as applied to claim 5 above, and further in view of Daniels, Jr. et al.

At the outset, it is noted that claim 6 contains the same subject matter found in claim 3 above. Claim 6 does not contain limitation regarding selectively tagging or identifying a particular class of emails (as found in claim 7). Therefore, claim 6 is grouped with claim 3 in the 103 rejection above (claim 6 was previously grouped with claim 7).

The further difference between Hogan and the claimed subject matter is the method of selectively tagging or identifying a particular class of emails for delivering either electronically or via traditional mail. Daniel, Jr. et al. discloses a method of sorting

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emails based on method of delivery and delivery designated emails via either postal mail or email (see at least Figs. 1 and 2, and description thereof). In particular, the printstream processor 102 selectively tags or identifies a particular class of emails based on the customer database delivery preference 202, for delivering either electronically via electronic inserter 110 or via traditional mail via physical inserter 106. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hogan with an option of sorting mails and delivering mails based on a recipient's choice via either email or traditional mail, as taught by Daniels, Jr. et al., for the purpose of upgrading the mail system of Hogan by adding capabilities (see Daniels et al., col. 1, lines 61-64) to the mail server of Hogan.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan in view of Daniel Jr. et al.

Hogan discloses a system for routing e-mails, comprising: a server (160, column 4, lines 36-44; column 9, lines 50-60; column 5, lines 22-36, for example) that includes a database, the database including a physical addresses and e-mail addresses of subscribers or recipients; in Hogan, each regular mail of a subscriber or recipient has a corresponding email address, wherein the server (160) is connected to a network (internet network 110, for example), further including an electronic mailbox (email box) for each physical address (regular mail, each subscriber or recipient must enter a physical address and email address into the data base of the server 160, see at least column 5, lines 25-35), wherein the electronic mailbox is associated with an account

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number and password (see at least Fig. 2a and description thereof; column 5, line 62 to column 6, line 8; column 10, lines 40-46); and a recipient host (PC 100 employed by a subscriber or recipient, for example) that includes a web browser, the recipient host connected to the network (110), wherein the host can access e-mails on the server (160) using the account number and the password. Further, it is clear that in Hogan, the recipient can print the email from the server (160) and send using regular mail. The recipient can also choose not to open the email, and as a result, the e-mail be printed and forwarded via regular mail. Also, it is clear that the server in Hogan, the recipient can print the email from the server (160), or the email can be printed and sent to the subscriber or recipient via regular mail if the subscriber or recipient chooses not to electronically make a payment by exiting the payment page. The recipient can also choose not to open the email, and as a result, the e-mail be printed and forwarded to the recipient via regular mail. With regard to claim 3, as discussed in claim 2, it is clear that the server (160) provides a graphical user interface (see Figs. 3 and 4, for example) that allows a recipient to select whether electronic mail is delivered to the electronic mailbox by selecting "203, receive and pay bill"); or is delivered via traditional mail by choosing not to electronically make a payment by exiting the payment page, or the recipient can also choose not to open the email, and as a result, the e-mail be printed and forwarded to the recipient via regular mail, and payment confirmation is sent to the recipient and sender. Furthermore, Hogan discloses that physical address and email address of a recipient are stored in a database.

Hogan does not disclose a means for mapping a physical address of a recipient to an email address of the recipient.

However, mapping a physical address to an email address is old and well-known in the art as evidenced by Infospace, cited previously and also below. Infospace provides an option of mapping a physical address to an email address; or in other words, searching a person's email address using a person's physical address in a data base comprising the person's physical address and email address.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hogan with an option of mapping a physical address to an email address; or in other words, searching a recipient's email address using a recipient's physical address in a data base comprising a recipient's physical address and email address, since the Examiner takes Official Notice that mapping a physical address to an email address; or in other words, searching a person's email address using a person's physical address in a data base is old and well-known as evidenced by at least Infospace, cited in the previous Office Action; and providing such a search capability to the e-commerce server 106 of Hogan, since a search engine is important and vital to the success of e-commerce, only involves ordinary skill in the art

The further difference between Hogan and the claimed subject matter is the method of selectively tagging or identifying a particular class of emails for delivering either electronically or via traditional mail. Daniel, Jr. et al. discloses a method of sorting emails based on method of delivery and delivery designated emails via either postal mail or email (see at least Figs. 1 and 2, and description thereof). In particular, the

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printstream processor 102 selectively tags or identifies a particular class of emails based on the customer database delivery preference 202, for delivering either electronically via electronic inserter 110 or via traditional mail via physical inserter 106. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hogan with an option of sorting mails and delivering mails based on a recipient's choice via either email or traditional mail, as taught by Daniels, Jr. et al., for the purpose of upgrading the mail system of Hogan by adding capabilities (see Daniels et al., col. 1, lines 61-64) to the mail server of Hogan.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan as applied to claim 5 above, and further in view of the following.

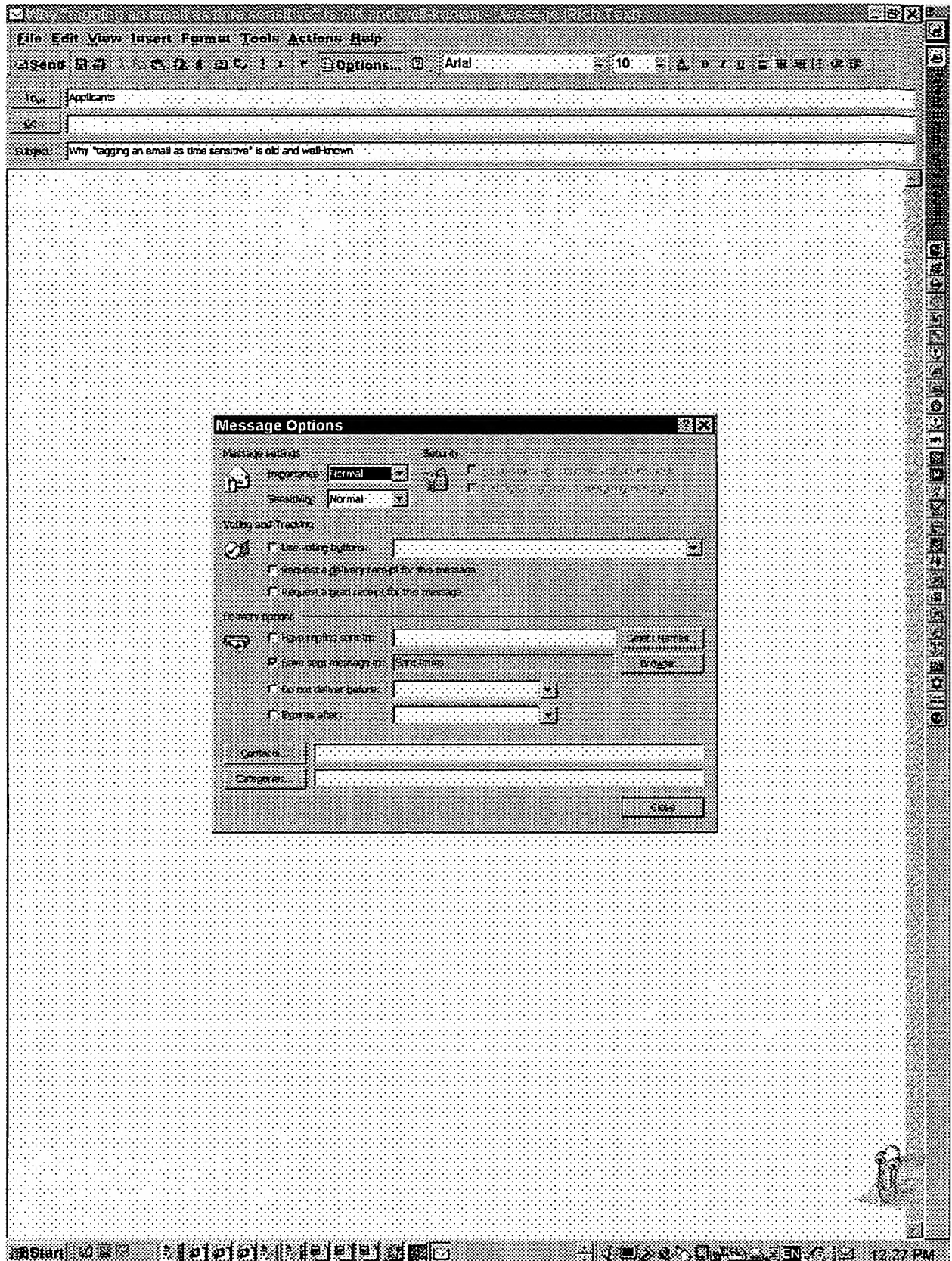
The further difference between Hogan and the claimed subject matter is tagging selected emails as time sensitive.

However, tagging selected emails as time sensitive is old and well-known as evidenced by Creswell et al. (6,775,690) or Microsoft Outlook, both previously cited. Creswell et al. (6,775,690) clearly states that "[f]requently, users send [email] messages in one form or another that are time sensitive. For instance, a reply to a message may be required by a certain date or the information in the message is no longer relevant." Another example is the commonly used Microsoft Outlook. The following is a screenshot showing "Message Options" in Microsoft Outlook. One can set the "importance" of an email by checking either Normal, High, or Low. It is clear that emails with High Importance level will require attention in a more timely fashion than those with

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Low Importance level. In another word, the emails sent using Microsoft Outlook can be tagged as time sensitive.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hogan with an option of tagging selected emails as time sensitive, since the Examiner takes Official Notice that tagging an email as time sensitive is old and well-known as evidenced by Creswell et al. (6,775,690) or Microsoft Outlook; and providing the email server of Hogan with an option of tagging selected emails as time sensitive for emphasizing the importance of a particular email only involves ordinary skill in the art.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan as applied to claim 5 above, and further in view of the following.

The further difference between Hogan and the claimed subject matter is the use of biometric data for accessing to an electronic mailbox.

However, the use of biometric data for accessing to an electronic mailbox is old and well-known as evidenced by Blair, III, cited in the previous Office Action. Baird, III et al. discloses an apparatus and method using biometric authentication process to allow users' access to a server. Note that the term "server" clearly includes an email server.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hogan with an option of using biometric data for accessing to an electronic mailbox, since the Examiner takes Official Notice that biometric data is old and well-known as evidenced by Blair, III, cited in the previous Office Action; and providing the email server of Hogan with an option of using biometric



data for accessing to an electronic mailbox to provide further and more effective protection over conventional ID and password only involves ordinary skill in the art.

Claims 5 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zoken.

Zoken discloses a method of storing an email in an electronic mailbox and mapping the email address of a recipient to a physical address of a recipient. However, Zoken does not disclose mapping the physical address of a recipient to the email address of a recipient.

However, mapping a physical address to an email address is old and well-known in the art as evidenced by Infospace, cited previously. Infospace provides an option of mapping a physical address to an email address; or in other words, searching a person's email address using a person's physical address in a data base comprising the person's physical address and email address.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Zoken with additional search capability such as mapping the physical address of a recipient to the email address of a recipient, since mapping a physical address to an email address or in other words, searching a recipient's email address using a recipient's physical address in a data base comprising a recipient's physical address and email address, is old and well-known in the art as evidenced by Infospace, since the Examiner takes Official Notice that mapping a physical address to an email address; or in other words, searching a recipient's email address using a

person's physical address in a data base is old and well-known as evidenced by at least Infospace, cited in the previous Office Action; and providing Zoken with an additional search capability only involves ordinary skill in the art to provide additional search capability to the Zoken.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Savino et al.

Savino et al. discloses a method for parcel delivery notification, comprising: receiving an electronic order for a parcel (received purchase order information); generating a parcel barcode representing at least a physical address of a buyer (see at least Fig. 5 and description thereof); scanning a parcel barcode (on a shipping label/packing slip); shipping the same parcel to a parcel delivery center; and scanning the same parcel barcode at said parcel delivery center.

Savino et al. does not disclose sending an email notification to a buyer when order is received and after shipment of order. Savino et al. also does not disclose mapping a physical address of a recipient to an email address of the recipient.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the steps of sending an email to a buyer after an on-line order is received and another email after the shipment of the order, since the Examiner takes Official Notice that sending email notification to a buyer after an on-line purchase is a common practice in e-commerce. One who places an order with Amazon.com or

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Dell.com, for example, will receive a notification email after an on-line order is received and another email after the shipment of the on-line order.

The further difference between the claimed subject matter and that of Savino is the mapping a physical address of a recipient to an email address of the recipient.

However, mapping a physical address to an email address is old and well-known in the art as evidenced by Infospace, cited in the previous Office Action. Infospace provides an option of mapping a physical address to an email address; or in other words, searching a recipient's email address using a person's physical address in a data base comprising the person's physical address and email address.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Hogan with an option of mapping a physical address to an email address; or in other words, searching a recipient's email address using a recipient's physical address in a data base comprising a recipient's physical address and email address, since the Examiner takes Official Notice that mapping a physical address to an email address; or in other words, searching a recipient's email address using a person's physical address in a data base is old and well-known as evidenced by at least Infospace, cited in the previous Office Action; and providing the Savino's mailing and delivering server(s) with such a search capability, since a search engine is important and vital to the success of e-commerce, only involves ordinary skill in the art.

**(10) Response to Argument**

**Appellants' Argument "A" :**

Appellants allege that "the Examiner has made troubling extensive statements regarding the Official Notice" and "the Examiner then spends pages mischaracterizing the Official Notice process. Appellants have provided detailed reasoned arguments refuting the statements of Official Notice, the motivation to combine and the sufficiency of them to provide a prima facie obviousness rejection." Appellants also, without any factual basis, state that "Appellants are not required to prove that something does not exist in the prior art."

In response to Appellants' argument, at the outset, it is noted that Appellants clearly fail to recognize that the Official Notice used in the previous Office Action was clearly **supported by documentary evidences**.

With regard to the use of Official Notice, Appellants' attention is **once again** directed to MPEP 2144.03.

MPEP 2144.03 clearly states that "it might not be unreasonable to take official notice of the fact that it is desirable to make something faster, cheaper, better, or stronger without the specific support of documentary evidence. Furthermore, it might not be unreasonable for the examiner in a first Office action to take official notice of facts by asserting that certain limitations in a dependent claim are old and well known expedients in the art without (emphasis added) the support of documentary evidence provided the facts so noticed are of notorious character and serve only to 'fill in the gaps'." Further, MPEP 2144.03(c) also clearly states that in order to "**adequately**

traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. (emphasis added). See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ ... A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate."

Thus, in light of the MPEP 2144.03, it is clear that a mere allegation or a bald statement such as, "Applicants respectfully request that the Examiner provide proof of these statements that predates the filing date of the above-captioned application" (see Appellants' previous response to challenge the Official Notice) is not adequate and does not shift the burden to the Examiner to provide evidence in support of the Official Notice. Allowing such a statement to challenge Official Notice would effectively destroy any incentive on the part of the Examiner to use it in the process of establishing a rejection of notoriously well-known facts. In the instant case, as noted above, Appellants have not provided any adequate information or argument so that on its face it creates a reasonable doubt regarding the circumstances justifying the Official Notice. However, in an effort to advance prosecution of this case, **supportive documentary evidences have already provided in the previous Office Action nevertheless in response to Appellants' inadequate challenge of the Official Notice (See Final Rejection).**

Contrary to Appellants' argument that "Appellants are not required to prove that something does not exist in the prior art," the facts presented in the documentary

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evidences, previously provided by the Examiner, clearly prove that old and well-known prior art **does exist**.

**Appellants' Argument "B" (35 USC 112 Rejection):**

The rejection of claims 1-4 and 11 are withdrawn.

In response to Appellants regarding claims 8 and 10, the Examiner maintains the rejection because the phrase ""sending an e-mail using physical address of a recipient" (claim 8) is unclear and misleading. It is common knowledge that one can only send emails using an email address, not a physical address. It is important to note that in claim 8, the step of "sending an email using a physical address" is performed before the step of "mapping said physical address of said recipient to an email address of said recipient." In claim 10, it is common knowledge that one can only send emails using an email address, not a physical address. The step of "mapping said physical address of said recipient to an email address of said recipient" cannot be found in claim 10. Without the step of "mapping," it is clear that the step of "sending an email address to a buyer... wherein a physical address of said buyer is used" cannot be performed.

**Appellants' Argument "C" (35 USC 103 Rejection):**

With regard to claims 1-5, 11, 13, 14, 16, and 17, Appellants argue that Hogan disclose a "subscriber's [or recipient's] personal data, including address and email, are stored" and Hogan does not disclose "a means for mapping a physical address of a recipient to an email address of a recipient."

In response to Appellants' argument, it is well settled that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, the rejection is based on a combination of Hogan and well-known prior art evidenced by documentary evidence (Infospace).

Appellants further argue that "[i]t seems quite clear that the element that the Examiner admits is missing from of the prior [Hogan] is not equivalent to the statement of Official Notice. Even if it were, there is not articulated motivation to combine them." Contrary to Appellants' argument, the Official Notice, used in the previous Office Action, was Official Notice **supported by documentary evidence**. It is clear that the rejection is NOT just simply based on a "statement of Official Notice" as alleged by Appellants, but rather a **detailed statement of Official Notice supported by documentary evidence**. In the instant case, the documentary evidence is a document from Infospace. Infospace provides an option of mapping a physical address to an email address; or in other words, searching a person's email address using a person's physical address in a database comprising the person's physical address and email address. It is noted that Appellants **conceded that** "Hogan discloses a "subscriber's [or recipient's] personal data, including address and email, are stored [in a data base]."

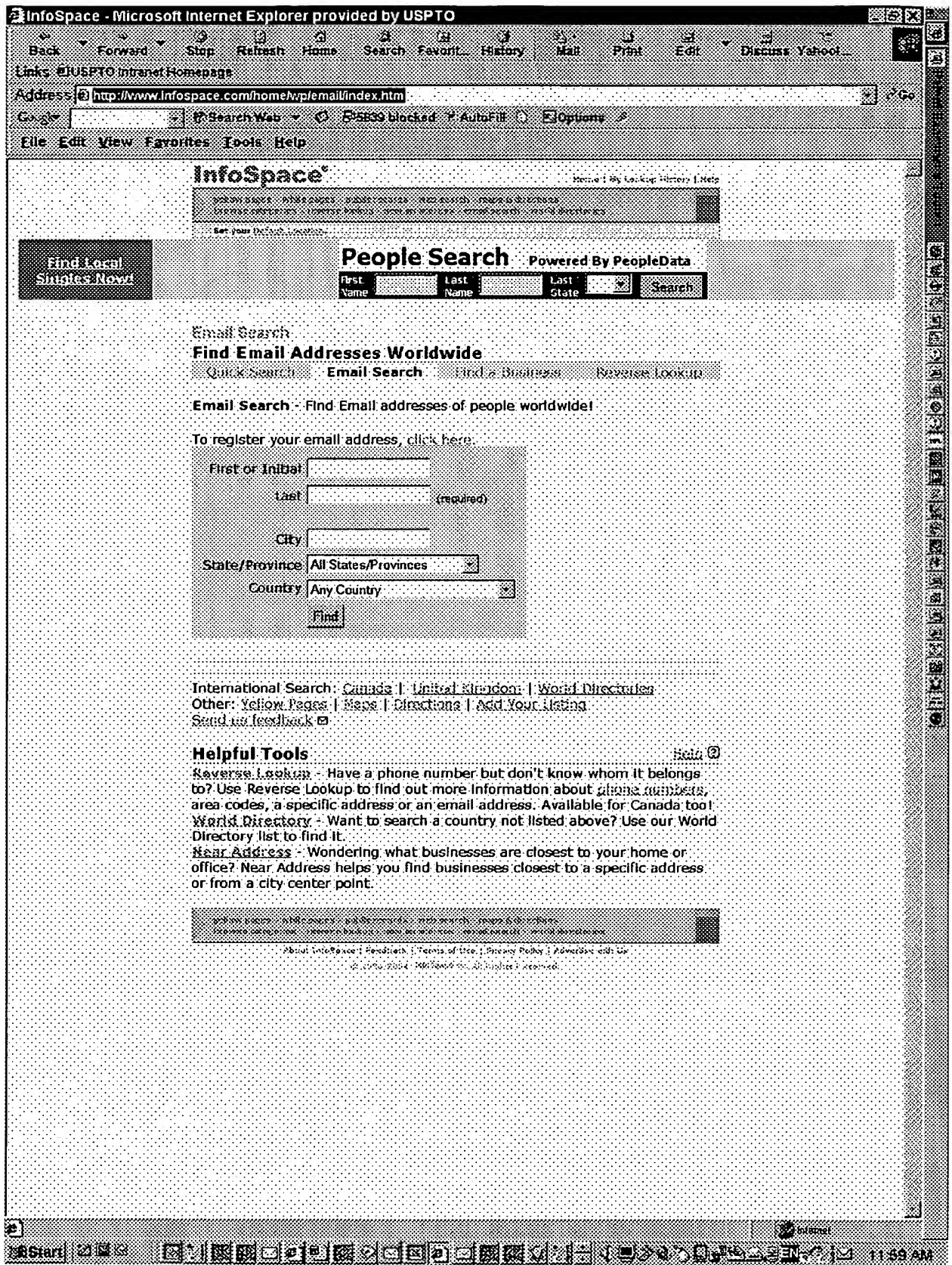
Appellants argue that "the Examiner takes Official Notice that searching for a particular predetermined information using a key word or phrase in a database is old and well known. The fact that searching a database is well known does not make it

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obvious to map a physical address to an e-mail address.” Contrary to Appellants’ argument, the Official Notice is not just about “searching for a particular predetermined information using a key word or phrase in a database.” The Official Notice is a **detailed statement supported by documentary evidence**. In the instant case, the documentary evidence is a document from Infospace. Infospace discloses searching for a predetermined information using a key word or phrase in a database. Specifically, Infospace provides an option of mapping a physical address to an email address; or in other words, searching a person’s email address using a person’s physical address in a database comprising the person’s physical address and email address. The following is a screenshot showing a typical search engine mapping an email address to a physical address:



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Appellants argue that "Appellants have respectfully requested that the Examiner provide a suggestion within the four corners of Hogan to use a physical address of a recipient to send an e-mail."

In response, Appellants seem to confuse between a 35 USC 102 rejection and a 35 USC 103 rejection. It is well settled that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, the rejection is based on a combination of Hogan and well-known prior art evidenced by documentary evidence (Infospace).

Appellants also argue that "the Examiner has often jumped to the conclusion that combining two well known elements or process steps is obvious without any suggestion or motivation within the prior art. This is Impermissible. Where prior art references require a selective combination to render obvious a claimed invention, there must be some reason for the combination other than hindsight gleaned from the invention disclosure."

At the outset, it is well settled that there are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). Obviousness can only be established by combining or modifying the teachings of the prior art to produce

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the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Further, the rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Eli Lilly & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990); *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988).

In response to Appellants' argument, a search engine is very important to the success of widely used e-commerce servers, such as Amazon.com or Dell.com, wherein one can search information on a product or service by using key word(s) or phrase(s). Similarly, web sites, such as Yahoo.com, or Microsoft Msn.com, for example, provides useful search engines for users. In addition, Google.com provides users with a powerful search engine, wherein relevant information can be easily found using key word(s) or phrase(s). As a matter of fact, a search engine is so important that almost

every e-commerce or public web site contains a search engine. There's no exception in the case of Infospace. Infospace provides a search engine to perform mapping a physical address to an email address; or in other words, searching a person's email address using a person's physical address in a database comprising the person's physical address and email address. Thus, it is clear that a search engine is very important to the success of e-commerce, and one of ordinary skill in the art would have recognized that a search engine, such as the one used in Infospace, is vital to Hogan's e-commerce. As clearly stated by the court, "**[t]he strongest rationale for combining references is a recognition, expressly or impliedly in the prior art** or drawn from a convincing line of reasoning based on established scientific principles or legal precedent, **that some advantage or expected beneficial result would have been produced by their combination**" (emphasis added). *In re Sernaker*, 702 F.2d 989, 994-95, 217 USPQ 1, 5-6 (Fed. Cir. 1983). Clearly, the combination of the e-commerce server of Hogan and a search engine for mapping a physical address of a subscriber or recipient to an email address of the subscriber or recipient is an expected beneficial result.

With regard to claim 5, Appellants argue that "the cited references do not teach or fairly suggest at least the mapping function." In response to Appellants' argument, see discussion above. **According to 37 CFR 1.196(b), if the Board determines that claim 5 is sufficiently broad enough that a 35 USC 102 may have been applied instead of the Examiner's 35 USC 103 rejection, the Examiner respectfully requests that the Board, in the decision, to include a statement that constitutes a**

**new ground of rejection of claim 5. The server, maintained by Infospace, allows a user to specify a physical address of a recipient in the address box, and performing mapping a physical address to an email address, or in other words, searching a recipient's email address using a recipient's physical address in a database comprising the recipient's physical address and email address. The user may then uses the obtained email address to send or route email to the recipient.**

With regard to claims 2, 3, 4, and 17, Appellants argue that "the Examiner has not articulated a rejection." Contrary to Appellants' argument, the basis of the rejection of claims 2-4, and 17, is clearly set forth in the rejection.

**Appellants' Argument "D" (35 USC 103 Rejection):**

With regard to claim 6, as noted above, contains the same subject matter found in claim 3. Claim 6 does not contain limitation regarding selectively tagging or identifying a particular class of emails (as found in claim 7). Therefore, claim 6 is grouped with claim 3 in the 103 rejection above (claim 6 was previously grouped with claim 7). With regard to claim 7, Daniel, Jr. et al. discloses a method of sorting emails based on method of delivery and delivery designated emails via either postal mail or email (see at least Figs. 1 and 2, and description thereof). In particular, the printstream processor 102 selectively tags or identifies a particular class of emails based on the customer database delivery preference 202, for delivering either electronically via electronic inserter 110 or via traditional mail via physical inserter 106.

**Appellants' Argument "E" (35 USC 103 Rejection):**

With regard to claims 8 and 9, Appellants argue that "Appellants respectfully disagree with the rejection for at least the reasons described above, especially with reference to claim 1." In response to Appellants' argument, see discussion above regarding claim 1. Further, as already discussed above, Daniel, Jr. et al. discloses a method of sorting emails based on method of delivery and delivery designated emails via either postal mail or email (see at least Figs. 1 and 2, and description thereof). In particular, the printstream processor 102 selectively tags or identifies a particular class of emails based on the customer database delivery preference 202, for delivering either electronically via electronic inserter 110 or via traditional mail via physical inserter 106.

**Appellants' Argument "F" (35 USC 103 Rejection):**

With regard to claim 12, Appellants argue that "Appellants respectfully disagree with the rejection for at least the reasons described above, especially with reference to claim 1."

In response to Appellants' argument, see discussion above regarding claim 1.

**Appellants' Argument "G" (35 USC 103 Rejection):**

With regard to claim 15, Appellants argue that "Appellants respectfully disagree with the rejection for at least the reasons described above, especially with reference to claim 5."

In response to Appellants' argument, see discussion above regarding claim 5.

**Appellants' Argument "H" (35 USC 103 Rejection):**

With regard to claims 5 and 13, Appellants argue that Zoken does not disclose "mapping a physical address of a recipient to an email address."

In response to Appellants' argument, it is well settled that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, the rejection is based on a combination of Zoken and well-known prior art evidenced by **documentary evidence** (Infospace). See also discussion above with reference to claim 1. **According to 37 CFR 1.196(b), if the Board determines that claim 5 is sufficiently broad enough that a 35 USC 102 may have been applied instead of the Examiner's 35 USC 103 rejection, the Examiner respectfully requests that the Board, in the decision, to include a statement that constitutes a new ground of rejection of claim 5. The server, maintained by Infospace, allows a user to specify a physical address of a recipient in the address box, and performing mapping a physical address to an email address, or in other words, searching a recipient's email address using a recipient's physical address in a database comprising the recipient's physical address and email address. The user may then use the obtained email address to send or route email to the recipient.**

**Appellants' Argument "I" (35 USC 103 Rejection):**

With regard to claim10, Appellants argue that Savino does not disclose mapping a physical address of a recipient to an email address, and use the obtained email address to send email.

In response to Appellants' argument, it is well settled that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, the rejection is based on a combination of Savino and well-known prior art evidenced by **documentary evidence** (Infospace). See also discussion above with reference to claim 1.



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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

*Khanh Dang*

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Primary Examiner  
July 14, 2005

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